

**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appellant(s) : Stefan Miersch
Serial No. : 10/008,603
For : Method and Apparatus for Producing Methane Gas
Filed : November 9, 2001
Examiner : Thanh P. Duong
Group Art Unit : 1764
Confirmation No. : 9226

CERTIFICATION OF SUBMISSION

I hereby certify that, on the date shown below, this correspondence is being transmitted via the Patent Electronic Filing System (EFS) at the U.S. Patent and Trademark Office.

Date: October 30, 2006


Jere Polmatier

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF UNDER 37 C.F.R. §41.41

This brief replies to the Examiner's Answer mailed August 29, 2006.

The Appellant wishes to address just a few points in the Examiner's Answer.

First, at several points on pages 8 and 9 of the Examiner's Answer, the Examiner makes arguments to the effect that the production of methane is a process limitation and, therefore, does not render patentability to the apparatus. However, one element of the "apparatus" is a "biomass material in a composition known to produce methane gas" and, as such, a methane-producing composition is a structural limitation and must be considered for patentability.

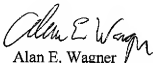
Second, the Examiner still has not adequately addressed the issue that the proposed modification both changes the principal of operation of Garvin et al. and renders the disclosure of Garvin et al. unsuitable for the purpose of Garvin et al. The Examiner, in trying to overcome the

principal of operation argument, states that the bags are moisture-proof and airtight. This argument ignores the fact that the bags are vented out to the atmosphere. See Garvin, et al., column 4, lines 20-26. The Examiner must consider the entire teachings of the disclosure. Until, or unless, the Examiner is able to show that the proposed combination of references does not impermissibly alter the principal of operation or the suitability for the purpose of Garvin et al., any and all arguments are merely impermissible hindsight. Moreover, on page 8, paragraph (2), the Examiner seems to admit that the proposed combination would not function very well for the purpose of the claimed invention either ("[A] much less valuable source of energy than when methane gas generates from anaerobic process").

Third, the Examiner has not shown that a continuation of the pipes in the prior art references direct methane gas to a gas collection site. As argued before, the prior art does not collect gas but instead disperses the gas to the atmosphere.

The Appellant believes that no fees are due with the submission of this Reply Brief. However, please charge any fees that may be due to Deposit Account No. 23-2053 and consider any necessary petition as provisionally made.

Respectfully submitted,



Alan E. Wagner
Registration No.: 45,188

Date: October 30, 2006

P.O. Address:
Whyte Hirschboeck Dudek S.C.
555 East Wells Street, Suite 1900
Milwaukee, WI 53202
Customer No. ~~29423~~ 22202